

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

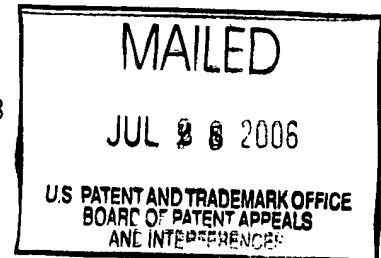
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CRAIG W. BARNETT, KAREN R. REISNER and MARK BRAUNSTEIN

Appeal No. 2005-2439
Application No. 09/754,378

ON BRIEF



Before JERRY SMITH, GROSS, and LEVY, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

ON REQUEST FOR REHEARING

Appellants request that we reconsider that portion of our decision of February 7, 2006 wherein we sustained the rejection of claims 76-112 as unpatentable under 35 U.S.C. § 103(a). Alternatively, appellants request that the previous decision be designated as a new ground of rejection.

Appellants' first argument in the request for rehearing is that the Board erred in finding that Von Kohorn and Saigh were analogous art. Specifically, appellants assert that the Board failed to consider either the field of endeavor of the two references or the problems with which the claimed invention and Saigh were concerned. They argue that the mere fact that Saigh may mention that coupons can be distributed over the Internet

alone does not render Saigh an Internet-based incentive distribution system. Appellants also reiterate that in Von Kohorn, measuring the effectiveness of different stimuli on user purchases is the field of invention. Appellants also argue that the Board's statement that Von Kohorn prints user-specific coupons at user terminals is unsupported [Request, pages 8-13].

We are again not persuaded by appellants' arguments that Von Kohorn and Saigh are non-analogous. Appellants focus on the portion of the overall process to which the individual references are directed instead of on the fact that the overall processes in the two references relate to and teach a coupon distribution system as claimed. Thus, Von Kohorn and Saigh are analogous art because they are in the same field of endeavor, that is, systems for distributing coupons. The fact that they relate to different aspects of a coupon distribution system does not make them non-analogous art. We also note that the examiner found that Von Kohorn taught all the features of the claimed invention except for the use of the Internet as the communication channel. Saigh was cited only to teach the use of the Internet in systems for distributing coupons. We still find that it would have been obvious to the artisan to replace the communication channels taught by Von Kohorn with the Internet as taught by Saigh. With respect to appellants' argument regarding the printing of user-specific coupons in Von Kohorn, it is taught at several locations in Von Kohorn that the coupons printed at the remote sites contain user identification information and verification codes.

Appellants also argue that the Board failed to consider the evidence as of the time appellants' invention was filed [Request, pages 13-15]. Although we agree with appellants that the language quoted from the decision was not well-chosen, we find, nevertheless, that the applied prior art supports the result reached in the decision. Saigh teaches the advantages of using the Internet in promotional delivery systems [column 14, lines 15+]. Since Von Kohorn teaches a promotional delivery system, the artisan would have found it obvious to replace the system taught by Von Kohorn with the Internet as taught by Saigh for the advantages taught by Saigh.

Appellants argue that the Board found obviousness of the claimed invention before all the facts were considered. Specifically, appellants refer to one portion of the decision in support of this argument [Request, pages 15-19]. Appellants have misunderstood the quoted portion of the previous decision. The quoted portion of the decision only states that the specific limitations of the claimed invention were being considered in light of the fact that the Board had already found that it would have been obvious to the artisan to replace the communication channel of Von Kohorn with the Internet as taught by Saigh and as noted above. The individual recitations of the claimed invention were then analyzed when Von Kohorn was viewed as operating over the Internet. Once the finding was made that it would have been obvious to employ the Internet in Von Kohorn, all the other findings made in the previous decision clearly follow.

Appellants have offered no substantive rebuttal of the findings other than to argue that they consist of hindsight. As noted above, the finding that it would have been obvious to use the Internet in Von Kohorn is not based on hindsight, but rather, is clearly suggested by Saigh.

Appellants argue that the examiner has failed to establish a prima facie case of obviousness [Request, pages 19-20]. To the extent that appellants made this argument in the briefs, we clearly did not agree. As noted above, all the claim features except for the Internet were taught by Von Kohorn according to the examiner. We considered each of appellants' arguments with respect to the individual features of the claimed invention that were allegedly not taught by Von Kohorn, and we did not find any of these arguments to be persuasive. In other words, we found that the examiner established a prima facie case of obviousness, and none of appellants' arguments persuasively rebutted this prima facie case.

Finally, appellants argue that the Board advanced its own rationale (instead of the examiner's rationale) to affirm the rejection. They argue that this constitutes a new ground of rejection because they have not had a fair opportunity to respond to this new rejection [Request, page 20]. Other than the bare statement that the Board advanced a new rationale for the rejection, appellants do not elucidate why they believe this. We have carefully reviewed the previous decision, and we can find nothing that would suggest that we changed the examiner's

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rationale in any way. While there are appeals related to this appeal where the Board did rely on different portions of Von Kohorn than the examiner, we do not find such a different rationale in the previous decision rendered in this case.

We have reconsidered our decision of February 7, 2006 in light of appellants' comments in the request for rehearing, and we find no error therein. We, therefore, decline to make any changes in our prior decision. We are still of the view that the invention set forth in claims 76-112 is unpatentable over the teachings of Von Kohorn and Saigh.

We have granted appellants' request to the extent that we have reconsidered our decision of February 7, 2006, but we deny the request with respect to making any changes therein.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

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REHEARING DENIED

Jerry Smith
JERRY SMITH

JERRY SMITH
Administrative Patent Judge

Anta Pellman Gross

ANITA PELLMAN GROSS
Administrative Patent Judge

BOARD OF PATENT
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STUART S. LEVY

STUART S. LEVY
Administrative Patent Judge

JS / gw

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PILLSBURY WINTHROP SHAW PITTMAN, LLP
P.O. BOX 10500
MCLEAN, VA 22102